



Attorney Docket No. 53326-000012
Serial Number: 10/020,136

#4
7C 9/7/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	Attorney Reference: 53326.000012
)	
Comiskey, et al)	Group Art Unit: 1734
)	
Serial No. 10/020,136)	Examiner: J. Lorengo
)	
Filed: December 18, 2001)	Class/sub: 427/256

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For: REFLECTED LIGHT GLARE MINIMIZATION FOR ATHLETIC CONTEST
PARTICIPANTS WHILE PROVIDING A NON-VERBAL COMMUNICATION

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In accordance with 37 C.F.R. §§ 1.56, 1.97, and 1.98, Applicants respectfully request consideration of the references listed on the attached Form PTO-1449.

Applicants respectfully request that the Examiner consider the references cited on the PTO-1449 and that the Examiner indicate that the references have been considered in this application by returning a copy of the Form PTO-1449 with the Examiner's initials in the left column per MPEP 609.

The references listed on the attached PTO-1449 are all references that were made of record in a related application, U.S. Patent Application Ser. No. 09/521,856, now U.S. Patent No. 6,350,338. The instant application is a divisional of U.S. Patent Application Ser. No. 09/521,856. U.S. Patent Application Ser. No. 09/521,856 is a continuation of U.S. Patent Application Ser. No. 09/217,074 (now U.S. Patent No. 6,096,154 ("the '154 patent")), which is a

continuation of U.S. Patent Application Ser. No. 08/240,895 (now U.S. Patent No. 5,939,142 ("the '142 patent"))).

The non-patent reference listed on the attached PTO-1449 are pleadings from a litigation involving the '154 Patent. The parties have since settled the aforementioned litigation and appeal, neither the district court nor the appellate court made a final decision regarding the validity of the '154 patent.

The PTO-1449 includes citations to two sets of pleadings. The first set of pleadings pertains to a Declaratory Judgement action filed in the U.S. District Court for the Eastern District of Virginia to ascertain the validity of the '154 patent and Motion for Preliminary Injunction to enjoin the patentee from sending notices of infringement to the Plaintiff's clients. The second set of pleadings relates to the patentee's Motion to the U.S. Court of Appeals for the Federal Circuit to Vacate or Stay the Preliminary Injunction granted by the District Court for the Eastern District of Virginia.

Paper Number 18 in the first set of pleadings is the transcript of an oral hearing on the Preliminary Injunction Motion. In that transcript, Judge Brinkema states her belief that the '154 patent is invalid because of its closeness to the Plaintiff's pre-existing patent. *See* pages A012, line 25-A013, line 2 and pages A018, line 22-A019, line 3. The Plaintiff's pre-existing patent, U.S. Patent No. 4,719,909, was considered by the Patent Examiner during prosecution of both the '142 patent and the '154 patent. The judge made the above statements without construing the claims or reviewing the file history.

In both sets of pleadings, the declaratory judgment Plaintiff argued that the '154 patent is invalid on multiple grounds including 35 U.S.C. §§ 101, 102, and 103. With regard to 35 U.S.C.

§ 101, the Plaintiff argued that the claims of the '154 patent constitute "printed matter" and are therefore invalid. The Plaintiff argued that as applied to its device, the claims of the '154 patent recite printed matter. Citing *In re Gulack*, 703 F.2d 1391, 1385 (Fed. Cir. 1983) and *In re Miller* 418.F.2d 1392, 1396 (CCPA 1969), the Plaintiff asserted that printed matter in a patent claim is not entitled to patentable weight unless it is functionally related to the underlying substrate. Plaintiff further argued that there is no functional relationship between the printed matter in the '154 patent and its substrate. Rather the printed matter and substrate perform two separate functions. *See, e.g.*, Memorandum of Law in Support of Plaintiff's Motion for Preliminary Injunction, (paper no. 10 in first set of pleadings), pages 9-11.

The defendant in the litigation, Stephen W. Comiskey, who is the owner of the '154 patent and who is one of the two applicants in the instant application, strenuously contested the Plaintiff's arguments. For example, the '154 patent and the Applicants of the instant application do not believe that the claims constitute printed matter within the meaning of 35 U.S.C. § 101. The Applicants of the present application assert that even if the claims of the '154 patent or the claims of the instant application were to be construed to include printed matter under 35 U.S.C. § 101, the substrate and shape are functionally related and, therefore, all claimed subject matter should be given patentable weight. The material performs both the functions of reducing glare and of providing non-verbal communication. The shape of the material (logo or lettering) performs the function of providing non-verbal communication and must be selected so as to effectively perform the function of reducing glare. Accordingly, the material and its shape function together to perform both the glare reduction and the non-verbal communication

functions of the claimed invention. *See, e.g.*, Defendant's Response to Plaintiff's Motion for Preliminary Injunction, (paper no. 11 in first set of pleadings), pages 12-14.

Furthermore, as stated in *Gulack*, a claim cannot be dissected to excise the printed matter and then declared unpatentable based on the mutilated remainder of the claim. *Gulack* at 1385. Printed matter may well constitute structural limitations upon which patentability can be predicated. *In re Royka* 490 F.2d 981, 985 (CCPA 1974).

The arguments that the Plaintiff advanced before the court with regard to 35 U.S.C. §§ 102 and 103 address only art that was already considered during the prosecution of the '154 patent. The Plaintiff (Mueller) argued that claims 1-8 of the '154 patent are invalid under 35 U.S.C. § 103 over its own patent in view of the prior art cheek decals (Team Spirit), which were cited on the face of the '142 patent. Plaintiff argued that its prior art patent differs from the claimed invention in that it does not disclose the shape of a logo or lettering identifying a manufacturer or distributor. The Plaintiff then argued that the prior art University cheek decals disclose the shapes of university logos and that a strong financial motivation existed to modify its prior art patent to form the shapes of logos (*Id.* at pages 12-13).

The Plaintiff also argued that the Examiner of the '154 patent used an incorrect legal standard for determining obviousness because he failed to consider that motivation to combine may be found in "the nature of the problem" and "the ordinary knowledge from those skilled in the art that certain references are of special importance in the field". See Plaintiff's Reply Memorandum in Support of Its Motion for Preliminary Injunction (paper No. 12 in first set of pleadings) page 11, 3rd paragraph.

Plaintiff further argued that claim 9 is anticipated by the prior art cheek decals because the decals are positioned on the cheek at a location where light is likely to be reflected into the eye and are shaped as sports equipment or apparel manufacturer's or distributor's logo or lettering. See Memorandum of Law in Support of Plaintiff's Motion for Preliminary Injunction, (paper no. 10 in first set of pleadings), pages 12 and 13.

In response, the Defendant (one of the applicants in the instant application) argued to the court that the references relied upon by the Plaintiff were, in fact, already considered by the Examiner and were cited on the face of the '142 patent. Further, even if combined, the references would not have resulted in the claimed invention. The decorative decals exhibited in the Team Dynamics Inc. catalog are not shaped, dimensioned or colored to be placed in a non-reflective under eye location or within a non-reflective under eye material such as that disclosed in the '154 patent. The tattoos also do not perform a non-reflective function and do not disclose a sports apparel or equipment manufacturer's or distributor's logo. Finally, although the Plaintiff established that solid glare reducing strips and decorative decals separately existed prior to the '154 patent, the "financial motivation" suggested by the Plaintiff was insufficient to render obvious any combination of the above-mentioned references which could have resulted in the claimed invention.

With regard to claim 9 of the '154 patent, the prior art decals are not dimensioned to cover a reflective location on the cheek. Since they are not made from a non-reflective material, it would not have been obvious to one of ordinary skill in the art to dimension the prior art decals to perform this function. Furthermore, the decals are not in the shape of an equipment manufacturer's or distributor's logo.

Subsequently, during discovery, Plaintiff produced the results of a validity search conducted with respect to the '154 patent by the Plaintiff. Plaintiff discusses the search results in paper number 38 of the first set of pleadings on pages 19-24 and 29. We believe that the references identified by the Plaintiff are merely cumulative of the art cited during the prosecution of the '142 and '154 patents. The parties settled the litigation before the court had an opportunity to consider these newly discovered references. A brief summary of each newly discovered reference is provided below.

U.S. Patent No. 1,761,664 to Harris discloses a nose protector for protecting the nose against sun and wind. The disclosure suggests that the nose protector may be used as an advertising novelty by printing advertising material thereon. *See* Col. 1, lines 12-15 and Col. 2, lines 65-67.

U.S. Patent No. 2,033,139 to Jefferis discloses a cosmetic applicator for applying rouge to the face. The apparatus is a shield or a stencil through which the wearer applies makeup.

U.S. Patent No. 2,851,805 to Allen discloses a temporary tattoo that has an opaque portion and a translucent portion which allows light rays to pass through in order to produce a tanning pattern. The opaque and translucent portions may be in various design configurations as shown in Figures 1-4.

U.S. Patent No. 3,594,813 to Sanderson discloses a protective device for protecting a body portion from the sun.

U.S. Patent No. 4,285,338 to Lemelson discloses an adhesive bandage having a printed illustration or design 22, 42 as shown in Figures 3-5.

U.S. Patent No. 4,979,811 to Boyer discloses an eyelid cover having an outer layer 18 provided with a decorative design 30. *See* Col. 3, lines 26-28 and Figure 2.

U.S. Patent No. 5,052,418 to Miller discloses a solar body tattoo 10. The solar body tattoo 10 may include a cutout central portion 12. The wearer applies zinc oxide paste within the cutout portion 12, removes the tattoo, and upon sun exposure allows the skin around the zinc oxide to darken. *See* Col. 4, lines 9-23.

In summary, the Plaintiff made the arguments set forth above in an attempt to invalidate the '154 patent. We do not believe that the Plaintiff's arguments are sufficient to invalidate the '154 patent and the Court never made a final validity determination. We respectfully request that these arguments be considered to the extent that they are relevant to the claims of this pending application.

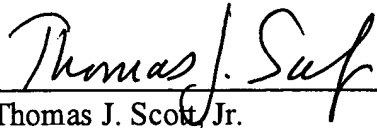
The attached PTO-1449 also lists a number of United States patents cited by the Examiner during the prosecution of Applicants' U.S. Patent No. 6,350,338 (Appl. No. 09/521,856). The patents cited by the Examiner during the prosecution of U.S. Patent No. 6,350,338 were: U.S. Patent Nos. 1,850,540 (Erickson); 2,842,142 (Peck); 4,719,909 (Micchia et al.); 4,745,916 (Seber); 5,592,687 (Lajeunesse); 5,609,150 (Maged); 5,718,224 (Muchin); 6,096,154 (Comiskey et al.); D434,524 (Kalfsky et al.); D441,081 (Mueller).

This IDS is submitted prior to the issuance of a first Office Action on the merits; therefore, it is believed that no fees are required in connection therewith. If any fees are necessitated by the filing of this Information Disclosure Statement, please charge the undersigned's Deposit Account No. 50-0206. A duplicate copy of this document is enclosed.

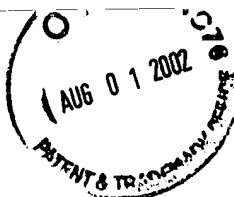
Respectfully submitted,
HUNTON & WILLIAMS

Date: August 1, 2002

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FORM PTO-1449 U.S. DEPARTMENT OF COMMERCE (REV. 7-80) PATENT AND TRADEMARK OFFICE LIST OF MATERIALS CITED BY APPLICANT (Use several sheets if necessary)	ATTY. DOCKET NO.: 53326.000012	SERIAL NO.: 10/020,136
	INVENTOR'S NAME: Comiskey et al.	EXAMINER: L. Lorengo
	FILING DATE: 12/18/01	GROUP: 1734

U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER							DATE	NAME	CLASS	SUBCLASS	FILING DATE
	U1	1	7	6	1	6	6	4	06/03/30	Harris			
	U2	1	8	5	0	5	4	0	3/1932	Erickson			
	U3	2	0	3	3	1	3	9	03/10/36	Jefferis			
	U4	2	8	4	2	1	4	2	7/1958	Peck			
	U5	2	8	5	1	8	0	5	09/16/58	Allen			
	U6	3	5	9	4	8	1	3	07/27/71	Sanderson			
	U7	4	2	8	5	3	3	8	08/25/81	Lemelson			
	U8	4	7	1	9	9	0	9	1/1988	Micchia et al.			
	U9	4	7	4	5	9	1	6	5/1988	Seber			
	U10	4	9	7	9	8	1	1	12/25/90	Boyer			
	U11	5	0	5	2	4	1	8	10/01/91	Miller			
	U12	5	5	9	2	6	8	7	1/1997	Lajeunesse			
	U13	5	6	0	9	1	5	0	3/1997	Maged			
	U14	5	7	1	8	2	2	4	2/1998	Muchin			
	U15	6	0	9	6	1	5	4	8/2000	Comiskey et al.			
	U16	D	4	3	4	5	2	4	11/2000	Kalfsky et al.			
	U17	D	4	4	1	0	8	1	4/2001	Mueller			

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION	
	F1						YES	NO

OTHER MATERIALS (Including Author, Title, Date, Pertinent Pages, Etc.)

P1	Pleadings for Civil Action No. 00-1993-A in the United States District Court for the Eastern District of Virginia (Alexandria Division) (with Tabs 1-48)
P2	Pleadings from Case No. 01-1141 in the United States Court of Appeals for the Federal Circuit (with Tabs 1-17)

EXAMINER

DATE CONSIDERED

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.